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PRE-APPEAL BRIEF REQUEST FOR REVIEW

	Docket Number (Optional)
	03-1106

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR ~~1.8(a)~~ 1.10	Application Number	Filed
	09/289,550	April 9, 1999
on ___October 19, 2005___	First Named Inventor	
Signature _____	Richard W. Friesen	
	Art Unit	Examiner
Typed or printed name ___Joseph A. Herndon___	3624	Kyle

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

[ ] applicant/inventor.

[ ] assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

[x] attorney or agent of record.   50,469
Registration number _____

[ ] attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____
Signature

Joseph A. Herndon
Typed or printed name

312-913-3331
Telephone number

October 19, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.
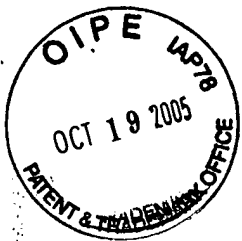
[ ] *Total of _____ forms are submitted.

PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

(Case No. 03-1106)

IN THE APPLICATION OF:)
    Richard W. Friesen et al.   )
)

Serial No.   09/289,550   )   Examiner: Charles R. Kyle
)

Filed: 04/09/1999   )   Group Art Unit: 3624
)

Title: User Interface For   )
            Electronic Trading System)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiners:

In response to the Advisory Action of August 16, 2005, the Applicants respectfully request review of the rejections of Claims 1, 2, 4, 10-12, 16, 18, 28, and 61-98. The following remarks are based on those presented in Applicants' RCE Remarks of April 1, 2004, ("Response 1"), Response of December 14, 2004, ("Response 2"), and Response of June 21, 2005, ("Response 3").

REMARKS

Applicants' presently claimed invention relates to a graphical user interface for electronic trading systems. In this pre-appeal brief, Applicants submit that a prima facie case of obviousness has not been shown because neither of the cited references show all of the claimed limitations, there is no motivation or suggestion to combine the references outside of the Examiner's "independently derived motivation," and combining them would not even result in the claimed invention. Applicants respectfully request reconsideration.

First Rejection under 35 U.S.C. § 103(a)

The Examiner's first rejection[1] included independent claims 1, 86, 87, and 90 under 35 U.S.C. § 103(a) as being unpatentable over US 5,136,501 to Silverman ("Silverman") in view of US 5,619,631 to Schott ("Schott"). Claims 86 and 90 have limitations that mirror the limitations found in Claim 1 and are patentable for similar reasons as Claim 1. With respect to independent Claim 87 and in spite of
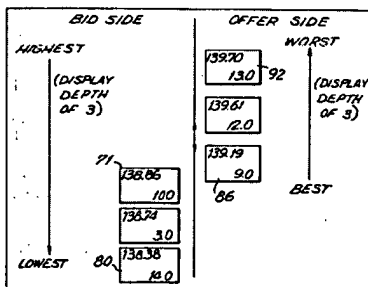
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[1] On page 2 of the Final Office Action of April 21, 2005, the Examiner rejected Claims 1, 2, 4, 10-12, 16, 18, 61-70 and 77-98 as being unpatentable over Silverman in view of Schott.

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Applicants' repeated remarks to correct the rejection, the Examiner continues to reject Claim 87 and directs us to the discussion of Claim 1.[2] However, Claim 1 does not show the limitations of Claim 87.[3] Instead, Claim 87 has similar limitations to Claim 72, which was rejected in view of different art. Applicants will therefore address Claim 87 separately in light of that art.

Claim 1 is directed to the displaying of an order icon that represents a user's order to buy or sell an item in the display of bid indicators and offer indicators positioned along a scaled axis.[4] According to Claim 1, the order icon can be moved to a location associated with a value along the scaled axis to facilitate placement of an order. Applicants submit that Claim 1 taken as a whole provides an advantage over the prior art (including the Silverman and Schott references) because it gives a user the ability to move an order icon representing his or her own order to a different value in a display of market bids and offers positioned along a scaled axis. Applicants know of no prior art reference that shows such limitations or a combination of elements or provides motivation to provide such features.

Silverman teaches an anonymous matching system through the use of logical models to illustrate the book market employed in the matching system.[5] The logical models referred to by the Examiner are not graphical user interfaces and it is impermissible to use them as displays. Instead, FIG. 4 of Silverman shows a logical model of a book database at the central system and FIG. 5 shows logical model of a book database at a keystation, which is a subset of the central station's book database. The boxes in FIGs. 4 and 5 are not indicators and cannot be used to teach indicators in a display as the Examiner asserts. Rather, the boxes illustrate database entries that are used by the Silverman's system to generate central and local keystation book databases, respectively. In spite of the logical models not being displays, the Examiner uses them in making the rejection of Applicants' display claims. When even making this impermissible assumption, the figures lack many claim limitations. The logical models only show bid and ask database entries at the prices where orders have been entered, and therefore, the Applicants agree with the Examiner's statement that Silverman does not disclose "the limitations of positioning of indicators along a scaled axis of values corresponding to an associated value."[6] Also, the logical models do not

FIG. 5
KEYSTATION BOOK

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[2] On page 12 of Response 2, Applicants' bring this mistake to the Examiner's attention for the first time.

[3] On page 9 of the Final Office Action of April 21, 2005, when rejecting Claim 72 – which calls for similar limitations as Claim 87 - the Examiner states that neither Silverman nor Schott show this limitation.

[4] Presently pending Claim 1 is on page 2 of Response 3. Applicants review Claim 1 on page 10 of Response 3.

[5] Applicants' review of Silverman is found in the last paragraph starting on page 13 of Response 1.

[6] On page 3 of the Final Office Action, the Examiner states that Silverman "does not specifically disclose the limitations of positioning of indicators along a scaled axis of values corresponding to an associated value or, in response to a user initiated command, moving an indicator (icon) to a location on the axis."

distinguish a user's own order from those entered by other users.[7] Applicants contend that because Silverman does not show indicators along a scaled axis, does not distinguish a user's own order, then it follows that Silverman does not also show, "in response to a user initiated command, moving an indicator to a location on the axis," as admitted by the Examiner.

Schott teaches data manipulation of representational dynamic graphs.[8] A user is able to manipulate a graph shape directly, which in turn not only modifies the graph, but also alters the corresponding and underlying tabularized data. The Examiner turns to Schott to teach what Silverman is lacking, namely, the positioning of bid/offer indicators along a scaled axis of values and the moving of the order icon associated with the user's own order. The Examiner asserts that the dynamic bar graph of Fig. 19A shows the scaled axis of values. Applicants contend that Schott does not show Applicants' "scaled axis of values," in which the values of the scaled axis are based on values associated with at least one bid and at least one offer. Additionally, the Examiner refers to Figs. 26A-26F (Figs. 26C and 26D are shown below to illustrate that a change in the pie chart makes an automatic change in the spreadsheet) whereby changing the size of one section of a pie chart will also change the corresponding number in the spreadsheet. With reference to these figures, the Examiner makes a general assertion that Schott teaches the moving of an order icon on a scaled axis of values called for in Applicants' Claim 1. Yet, Applicants submit that Schott makes no reference to, or mention whatsoever of, facilitating placement of an order to buy/sell an item by moving the order icon to a location along the first scaled axis of values.

Fig. 26C.   Fig. 26D.
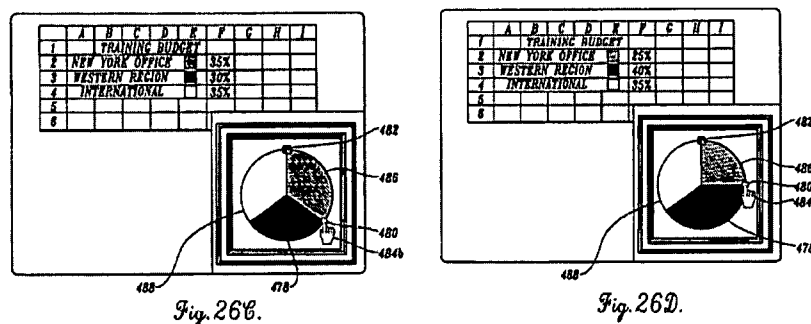
Applicants submit that Silverman and Schott, taken alone, or in combination, do not describe or suggest the limitations of Claim 1. Neither reference teaches to display bid/offer indicators, nor do they teach the display of bid/offer indicators along a scaled axis of values. Neither reference shows displaying an order icon associated with a user's order for a particular quantity of the item. Neither reference shows moving the order icon to a location associated with a value along the scaled axis of

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[7] Applicants review of this issue can be found on page 15 of Response 1.
[8] Applicants review of Schott is found in the last paragraph at the bottom of page 10 of Response 2 and in the first paragraph on page 12 of Response 3.

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values. The Examiner did not show otherwise, and therefore, each of the limitations of Claim 1 are not found in the prior art, which is required to make a prima facie case of obviousness.[9]

Additionally, the Examiner failed to show a proper suggestion or motivation to modify or combine the reference teachings.[10] While combining the references would not lead to Applicants' claimed invention (both lack the same limitations as stated above), neither reference shows motivation for making the modification suggested by the Examiner. Furthermore, no reference suggests the desirability of providing this type of graphical control over a user's own order in the display of bids/offers. Indeed, the Examiner has stated that no motivation exists outside of the Examiner's own, "independently derived motivation" to combine the references.[11] However, because the Examiner did not provide any evidence to support this independent derivation, the Examiner's independently derived motivation cannot stand.[12]

Second Rejection under 35 U.S.C. § 103(a)

The Examiner's second rejection included Claim 28 under 35 U.S.C. §103(a) as being unpatentable over Silverman, in view of Schott and further in view of US 6,188,403 given to Sacerdoti et al. ("Sacerdoti"). Claim 28 depends from Claim 1, and hence adds a further limitation to Claim 1. The limitations of Claim 28 include moving an order token to a user specified location with respect to a first scaled axis of values which corresponds to a desired value, thereby enabling placing of the order in accordance with the desired value.[13] As explained above neither Silverman nor Schott, alone or in combination, discloses a method of moving order tokens. Sacerdoti fails to overcome this deficiency as well. Sacerdoti describes a 3-dimensional graphics generation and display application that provides a visual display of information retrieved from a database.[14] Sacerdoti fails to disclose or suggest displaying order tokens, or enabling placing of the order in accordance with the desired value based on the location of the order token. Thus, the limitations of Claim 28 are not found in the prior art.

The Applicants also disagree with the Examiner that Sacerdoti includes a motivation to combine the reference based on, what Examiner refers to as "common subject matter of trading."[15] The Applicants note that the sections cited by the Examiner discuss the importance of effective

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[9] M.P.E.P. 2142-2143.03.

[10] M.P.E.P. 2143.01 (8th ed. Aug. 2001), citing In re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d (BNA) 1453, 1457-58 (Fed. Cir. 1998) ("The combination of references taught every element of the claimed invention, however without a motivation to combine, a rejection based on prima facie case of obviousness was held improper.")

[11] On page 13 of Response 3, Applicants review the Examiners statement, "In this case, the Examiner has clearly set out an independently derived motivation to combine," which can be found on page 13 of the Final Office Action.

[12] M.P.E.P 2144.03(A) states that it is never appropriate to rely solely on common knowledge in the art without prior evidentiary support in the record as the principal evidence upon which a rejection was based.

[13] Presently pending Claim 28 is on page 4 of the Response 3.

[14] See Abstract in Sacerdoti.

[15] On page 8 of the Final Office Action, "A motivation to combine the teachings of the references is given by Sacerdoti *et al* at Col. 1, lines 20-64 as common subject matter of trading."

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presentation of computer-stored data rather than graphical user interfaces for electronic trading system.[16] Thus, the Examiner failed to show proper suggestion or motivation to combine the reference teachings.
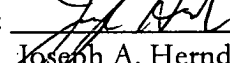
Third Rejection under 35 U.S.C. § 103(a)

The Examiner's third rejection included Claims 71-76 under 35 U.S.C. §103(a) as being unpatentable over Silverman, in view of Schott and further in view of US 6,161,099 given to Harrington et al. ("Harrington"). Claims 71-76 depend from Claim 1 and add further limitations of "a derivative of price" to Claim 1.[17] Also, as mentioned above, independent Claim 87 discloses the same limitation. The Examiner asserted that Silverman did not disclose a derivative of price, but tried to overcome this deficiency using Harrington (specifically pointing to: "[t]he user enters a coupon for each maturity and an aggregate purchase price, and at the Issuer's option, a price or yield for each maturity.")[18] Applicants contend that this statement in Harrington does not overcome the deficiencies of Silverman and Schott, since such a statement does not teach or suggest displaying indicators at locations corresponding to values representing a derivative of price.[19]

Conclusion

The cited references do not show every limitation found in Applicants' presently pending independent Claims 1, 86, 87 and 90. Further, while combining the references would not result in the Applicants' claimed invention given the references lack the very same limitations, the Examiner cannot point to any motivation or suggestion to combine or modify the references to achieve Applicants' invention. Applicants' dependent claims are also patentable for distinct reasons, however, because the remaining rejected claims depend either directly or indirectly from one of the independent claims, the dependent claims were not entirely addressed in this pre-appeal brief for sake of space. Applicants submit that the present application is in condition for allowance and notice to that effect is hereby requested.

Respectfully submitted,

Date: 10/19/05

By: _____
Joseph A. Herndon
Reg. No. 50,469

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[16] See Sacerdoti, Col. 1, line 20-64.
[17] Presently pending Claims 71-76 on page 5 of Response 3.
[18] On page 9 of the Final Office Action.
[19] On page 15 of Response 3.